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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/506,032	07/24/1995	DONALD K. FOREST		9822

7590 12/23/2003
DONALD K FOREST
27 South Warner Ave.
Bryn Mawr, PA 19010-2608

EXAMINER

LIANG, REGINA

ART UNIT	PAPER NUMBER
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2674

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DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/506,032

Applicant(s)

FOREST, DONALD K.

Examiner

Regina Liang

Art Unit

2674

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 19-41, 43-58, 61-80, 82-89, 94, 101-106, 108 and 112-276 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 19-41, 43-58, 61-80, 82-89, 94, 101-106, 108, 112-276 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 19-41, 43-58, 61-80, 82-89, 94, 101-106, 108, 112-276 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-83 of U.S. Patent No. 6,160,536. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 19-41, 43-58, 61-80, 82-89, 94, 101-106, 108, 112-205 of this application are broader version of patented claims.

The following is an example for comparing claim 85 of this application and claim 9 of U.S. Patent No. 6,160,536.

Claim 85 of this application	Claim 9 of U.S. Patent No. 6,160,536
An apparatus for selecting a menu option from a plurality of menu options, said apparatus comprising: a surface;	For use with a user interface system wherein a body member of a user indicates successive locations with respect to a surface, a menu option selector comprising:

means for delimiting a plurality of selectable regions on the surface, the plurality of selectable regions together at least partially circumscribing a region on the surface;	the surface with a respect to which a selectable region is capable of being at least partially delimited, the selectable region associated with a menu option;
a pointer, responsive to the movement of a body member of a user, for indicating successive locations on the surface; sensor signal receiving means for receiving a sensor signal; and	a detector for detecting the successive locations indicated by the body member, and
	an indicator for indicating the duration of each of: a first period of time during which two or more of the successive locations intersect the selectable regions; a second period of time, occurring after the first period, during which two or more of the successive locations do not intersect the selectable regions, and a third period of time, occurring after the second period, during which two or more of successive locations intersect the selectable region; and

selection means responsive to the sensor signal, for associating each of the selectable regions respectively with the menu options of one of the plurality of menu options, and responsive to a quantity equaling or exceeding a predetermined quantity, the quantity being a function of the durations of one or more successive periods of intersection of two or more of the successive locations and a particular selectable region, for selecting the menu option associated with the particular selectable region.	a selection device, responsive to a first quantity equaling or exceeding a first predetermined quantity, the first quantity being a function of the duration of each of the first, second, and third periods, for selecting the menu option.
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As can be seen above, claim 85 of this application is similar to claim 9 of U.S. Patent No. 6,160,536 and is broader version of patented claim 9. Claim 9 of U.S. Patent No. 6,160,536 has additional limitation of an indicator for indicating the duration of a first, second and third periods of time, however, the differences are not patentable distinct because it would have been obvious to have an indicator in the device in order to indicate to a user a passing of the predetermined quantity, where the quantity being a function of the durations of one or more successive periods of intersection of two or more of the successive locations and a particular selectable region, in order to accurately select the desired selectable region.

Response to Arguments

3. Applicant's arguments filed 10/14/03 have been fully considered but they are not persuasive since there is no terminal disclaimer to US. Patent No. 6,160,536 (SN 08/913,822) and the terminal disclaimer filed 9/28/1998 do not reference US. Patent No. 6,160,536 at all.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Regina Liang whose telephone number is (703) 305-4719. The examiner can normally be reached on Monday-Friday from 9AM to 5:00PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe, can be reached on (703) 305-4709. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


REGINA LIANG
PRIMARY EXAMINER
ART UNIT 2674

RL
12/18/03